REMARKS/ARGUMENTS

Applicant has received and carefully reviewed the Office Action of the Examiner mailed April 6, 2007. Claims 1-34 remain pending. Claim 21 has been amended to correct a typographical error. No new issues are raised and no new search is necessitated by this amendment. Applicants respectfully request the amendment be entered. Reconsideration and reexamination are respectfully requested.

Allowable Subject Matter

Applicants thank the Examiner for indicating that claims 1-20, 29, and 30 are allowed.

Claim Objection

Claim 21 is objected to for a typographical error. The error has been corrected with this amendment.

Rejection under 35 U.S.C. § 102(b)

Claims 21-28 and 31-34 remain rejected as being anticipated by Hill et al. (EP 1 196 003 A2). Applicant traverses the rejection.

Independent claim 21 recites, in part, the specific method step of:

performing one or more tests on each of the HVAC systems in response to the test request, and producing a test result for each of the HVAC systems, wherein at least one of the one or more tests that is performed activates and tests one or more of the active or dormant component of an HVAC system

(Emphasis added). The Examiner asserts that the system of Hill et al. performs one or more tests on each of the HVAC systems in response to a test request, and that at least one of the one or more tests that is performed activates and tests one or more of the active or dormant components of an HVAC system. Applicant respectfully disagrees.

Contrary to the Examiner assertions, Hill et al. do not appear to teach, disclose or suggest performing one or more tests on each of the HVAC systems in response to the test request, and

producing a test result for each of the HVAC systems, wherein at least one of the one or more

tests that is performed <u>activates</u> and tests one or more of the active or dormant component of an

HVAC system, as recited in claim 21. The Examiner cites to paragraph 16, lines 6-7 for

performing one or more tests on each of the HVAC systems <u>in response</u> to the test request.

Paragraph 16 of Hill et al. states:

> Referring to Fig. 1, an entry device 10 such as a WAP (Wireless Access
> Protocol) cell phone, a handheld computer, or a PDA (Personal Digital Assistant)
> connects to a server 12 either via the Internet or a GSM/Internet interface. Entry
> device 10 is any device that allows a user to enter or receive data, whether over
> wireless or wired communication paths. Server 12 in turn is connected to an
> HVAC device 14 through the Internet and/or some other communications link
> such as the GSM Network or POTS (plain old telephone system) network. A user
> uses the entry device 10 to <u>access diagnostic or status information</u> relating to
> HVAC device 14. Typical users include an individual owner who wishes to
> change a setpoint, a service technician who wishes to check diagnostic
> information, or a building supervisor who wishes to control a number of devices
> (emphasis added).

Emphasis added. At most, this passage of Hill et al. suggests <u>accessing</u> and <u>checking</u> diagnostic

or status information related to an HVAC device 14. The diagnostic or status information would

appear to be generated by the HVAC device 14 itself, and not in response to any request of Hill

et al. Clearly, nothing in this passage of Hill et al. suggests <u>performing one or more tests</u> on each

of the HVAC systems <u>in response to the test request</u>, as recited in claim 21. Rather, this

passage of Hill et al. only suggests <u>accessing</u> and <u>sending</u> diagnostic or status information (that is

likely self generated by the HVAC system at some previous time) upon request.

The Examiner cites to column 4, paragraph 0028, lines 28-33, as suggesting that the one

or more tests that is performed in response to a test request <u>activates</u> and tests one or more of the

active or dormant component of an HVAC system. Notably, the exact portion of Hill et al. cited

by the Examiner (column 4, paragraph 0028, lines 28-33) is not clear because column 4 does not

contain paragraph 0028, and paragraph 0028 does not cover lines 28-33. Paragraph 0028 recites:

> In step 530, server 12 checks to see if a message has been received to
> display diagnostic information such as that shown in Fig. 7. If so, the database is
> queried in step 532 for the diagnostic information, after which the diagnostic
> information is sent in step 534. Control then passes to step 524.

Notably, this passage of Hill et al. appears to suggest that the server <u>displays diagnostic</u> <u>information</u> in response to a request. This clearly does not teach, disclose or suggest <u>performing</u> <u>one or more tests</u> that <u>activate</u> and test one or more of the active or dormant components of the HVAC system <u>in response to the test request</u>, as recited in claim 21.

On the top of page 4 of the Office Action, the Examiner also refers to paragraph 0007 of Hill et al. for teaching a system that activates and tests a primarily active or dormant component of the HVAC system in response to a test request. This portion of Hill et al. states:

> [0007] According to an embodiment of the invention, a method for remotely monitoring and controlling at least one HVAC device includes the steps of (a) providing a server with communications access to an entry device and the at least one HVAC device; (b) <u>querying</u> the at least one HVAC device for <u>status</u> <u>information</u> on a regular basis or when requested by a message from the entry device; (c) <u>sending the status information</u> to the entry device in response to the querying; (d) <u>checking for messages</u> from the at least one HVAC device; (e) automatically <u>updating a database</u> in the server relating to a status of the at least one HVAC device on a regular basis in the absence of the message from the entry device; and (f) changing settings on the at least one HVAC device from the entry device.

Emphasis added. Merely querying for status information, checking for messages, and displaying diagnostic information in response to a request cannot be seen to anticipate the claimed step of <u>activating</u> an HVAC component. Hill et al. appear to teach a system that monitors and obtains diagnostic information upon request, but does not appear to teach, disclose or suggest a step of activating a component <u>in response to a test request</u>, as recited in claim 21. For these and other reasons, Hill et al. thus cannot be seen to anticipate independent claim 21.

Independent claim 31 recites:

> 31. (previously presented)   A method of remote testing of HVAC systems comprising the steps of:
> transmitting one or more maintenance signals from a remote unit to a specified group of customer HVAC systems, the specified group being a number less than a total number of customer HVAC systems in a customer database;
> receiving the one or more maintenance signals at each of the HVAC systems, the one or more maintenance signals <u>activating</u> an HVAC component;

performing a self-test on the activated HVAC component <u>based on the received one or more maintenance signal</u>;

generating self-test result signals from the activated HVAC component based on the self-test preformed on the activated HVAC component;

transmitting the self-test result signals from the HVAC system to the remote unit; [[and]]

receiving the self-test result signals from the HVAC systems at the remote unit; and

storing the self-test result signals at the remote unit.

As can be seen, claim 31 recites the step of receiving one or more maintenance signals at each of the HVAC systems, the one or more maintenance signals <u>activating</u> an HVAC component. For reasons similar to those set forth above, Hill et al. cannot be seen to anticipate such an activating step. Notably, claim 31 also recites the step of performing a self-test on the activated HVAC component <u>based on the received one or more maintenance signal</u>. Again, and for similar reasons, Hill et al. cannot be seen to anticipate such a step.

The Examiner appears to be asserting that the system of Hill et al. <u>could</u> perform the claimed method steps. The rejection is an anticipation rejection and thus requires a reference that teaches each and every element of the claim. MPEP 2131 states, "A claim is anticipated only if <u>each and every element as set forth in the claim</u> is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Emphasis added. MPEP 2131 goes on to state that, in order to anticipate a claim, "'[t]he <u>identical invention</u> must be shown in as complete detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." Emphasis added.

Hill et al. clearly do not teach the method step of performing one or more tests on the HVAC system components, where the test that is performed <u>activates</u> and tests the component, as is recited in claim 21. Hill et al. do not appear to teach the method step of receiving one or more maintenance signals that activate an HVAC component, as is recited in claim 31. Hill et al. appear to teach a method in which an HVAC device is queried for <u>status information</u>. See paragraphs 0004-0007. Hill et al. also teach "server 12 checks to see if a message has been

received to <u>display diagnostic information</u> such as that shown in Fig. 7. If so, the <u>database is</u>
<u>queried</u> in step 532 <u>for the diagnostic information</u>, after which the diagnostic information is sent
in step 534." Emphasis added; see paragraph 0028. Hill et al. also state:

> <u>Status information</u> on the HVAC devices which is <u>contained in the unit database</u>
> is either updated on a regular basis or when requested by a message from the
> entry device. That is, <u>status information</u> can be sent to the server by the HVAC
> controller on a regular basis, or the server can request the <u>status information</u> from
> the HVAC controller on a regular basis, in addition to or in place of the server
> requesting status information in response to a message from the entry device.

Emphasis added; see paragraph 0032. Hill et al. thus appear to teach a system in which status
<u>information</u> is requested and provided. Hill et al. do not, however, appear to teach the specific
method steps recited in claims 21 and 31 regarding, for example, <u>activating</u> a component of an
HVAC system <u>in response to a test request</u>.

If the Examiner is considering the specific method steps recited in the claims to be
<u>inherent</u> in Hill et al., Applicants submit that there is no basis for such an interpretation. MPEP
2112 IV. states:

> The fact that a certain result or characteristic <u>may</u> occur or be present in the prior
> art is not sufficient to establish the inherency of that result or characteristic. *In re*
> *Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed
> rejection because inherency was based on what would result due to optimization
> of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666
> F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the
> extrinsic evidence 'must make clear that the missing descriptive matter is
> **necessarily present** in the thing described in the reference, and that it would be
> so recognized by persons of ordinary skill. Inherency, however, may not be
> established by probabilities or possibilities. The mere fact that a certain thing may
> result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169
> F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

(Emphasis added). Applicants submit that the claimed method steps, in particular the step of
<u>activating</u> a component of the HVAC system, is not <u>necessarily</u> present in Hill et al. It appears
the Examiner is asserting that the claimed method steps <u>could</u> be performed by the system of Hill
et al., which is not a proper basis for rejection, especially for an anticipation rejection.

With respect to claim 25, the Examiner points to paragraph 32, lines 46-50 of Hill et al. as teaching the step of identifying which of the HVAC systems will likely need service by analyzing the test results. This passage of Hill et al., however, states:

> Status information on the HVAC devices which is contained in the unit database is either updated on a regular basis or when requested by a message from the entry device.

Applicant submits that Hill et al.'s teaching of updating status information in a unit database cannot be seen to anticipate the specific method step of analyzing test results and identifying which of a plurality of HVAC systems will likely need service based on those test results, as is recited in independent claim 25. Moreover, and for similar reasons to those given above, Hill et al. clearly does not disclose the steps of transmitting a test request to each of the plurality of HVAC systems from the remote location, and performing one or more tests on at least selected ones of the HVAC systems in response to the test request, as recited in claim 25. As such, Hill et al. cannot be seen to teach each and every element of claim 25, and thus cannot be deemed to anticipate claim 25 or the claims dependent thereon.

In the Response to Arguments section on page 9, under number 2, responding to Applicants' prior argument that Hill et al. does not teach performing a test/diagnostics, but merely teaches requesting diagnostic information, the Examiner cites column 4, paragraph 0029, lines 39-40 of Hill et al. As paragraph 0029 is found in column 5, lines 26-30, Applicants are assuming the correct citation is to paragraph 0029. If this is not correct, Applicants respectfully request clarification of the portion of Hill et al. being relied upon. Under number 5, the Examiner also relies on paragraph 0029 for teaching a test that activates a component. Paragraph 0029 of Hill et al. states:

> In step 537, server 12 checks to see if a message has been received to change unit information such as that shown in fig. 7. If so, the database is updated in step 537, after which a message is sent to the unit in step 539. Control then passes to step 536.

As can be seen, this portion of Hill et al. teaches a system that receives messages and updates a database accordingly. This portion of Hill et al. clearly does not teach a specific method step of

performing a test/diagnostic on the HVAC system, or activating a component of the HVAC system in response to a test request. The Examiner asserts that the prior art is clearly testing the HVAC component, and since the system only has either an active or dormant state it must be testing one or the other. For the reasons set forth above, as well as other reasons, Hill et al. cannot be seen to teach performing a test or diagnostic on the HVAC system in response to a test request and additionally, cannot be seen to teach activating a component of the HVAC system in response to such a test request.

Under number 6, the Examiner has also relied on paragraph 0029 of Hill et al. for teaching analyzing test results and identifying which of a plurality of HVAC systems will likely need service based on those results. Paragraph 0029, quoted above, clearly does not teach such a specific method step. Further, the step of checking for messages and updating a database cannot be seen to anticipate the specific claimed step of analyzing test results and identifying which HVAC systems will likely need service. As stated above, an anticipating rejection requires each and every element of the claims be taught. Hill et al. do not teach or even suggest the specific method steps recited in the independent claims, or the claims dependent thereon.

Regarding claim 26, the Examiner asserts that Figure 1 of Hill et al. teaches the step of providing different test requests to at least two of a plurality of HVAC systems, wherein each test request identifies a different test to be performed. Figure 1 merely illustrates two entry devices in communication with a server that is in communication with two HVAC devices. Neither Figure 1, nor any other portion of Hill et al., appears to teach the specific method steps recited in claim 26. As noted above, Hill et al. do not appear to transmit any test requests, as asserted by the Examiner. In the Response to Arguments section, under number 7, the Examiner again points to paragraph 0029 of Hill et al. as teaching transmitting test requests. As indicated above, paragraph 0029 appears to teach checking for messages received to change unit information and if so, updating the database. As discussed above, this portion of Hill et al. clearly does teach or suggest transmitting test requests, but merely receives messages and updates a database accordingly.

Regarding claim 27, the Examiner asserts that it is within <u>reasonable interpretation to</u> <u>infer</u> that a service technician would charge for his/her services. Applicant respectfully traverses this rational. As stated above, making an assumption as to a method step that is not supported by a specific teaching in a reference would be an improper basis for an anticipation rejection. Additionally, even if such assumption were correct, the assumption that a technician would charge for work does not meet the elements of the claim. Claim 27 recites the step of charging an owner an amount that depends on <u>the particular test</u> that is performed on the HVAC system. Hill et al. do not appear to teach such a specific method step.

In the Response to Arguments section under number 8, the Examiner asserts that paragraphs 0003 and 0029 of Hill et al. illustrate that a cost is associated with services performed by the technician. Applicants have reviewed the portions of Hill et al. and have found no teaching or suggestion of costs. Further, as indicated above, claim 27 requires the specific method step of charging an owner an amount that depends on the <u>particular test</u> that is performed on the HVAC system. Hill et al. do not appear to teach or suggest such a specific method step.

Regarding claim 28, the Examiner asserts that Hill et al. teach the method step of scheduling service on at least some of the HVAC systems that have been identified as likely needing service, as is recited in claim 28, citing paragraph 7, lines 30-35 and paragraph 0029 for support. Applicant has carefully reviewed these passages in Hill et al. and has found no such teaching. Hill et al. teach a method in which status information is provided upon request and updated on a server, and in which settings on at least one HVAC device are changed from an entry device. Hill et al. do not appear to teach any steps relating to <u>scheduling service</u> for HVAC systems that have been identified as likely needing service.
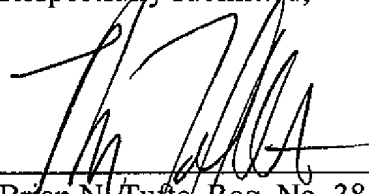
For at least the reasons set forth above, Hill et al. fail to teach each and every element of the claims and cannot be deemed to anticipate the claims. Reconsideration and withdrawal of the rejection is respectfully requested.

Reconsideration and reexamination are respectfully requested. It is submitted that, in light of the above remarks, all pending claims 1-34 are now in condition for allowance. If a

telephone interview would be of assistance, please contact the undersigned attorney at 612-359-9348.

Respectfully submitted,

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